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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/586,410 | 06/01/2000 | Mark Clark | 00 P 7661 US | 6338 |

7590

08/12/2005

Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

NAHAR, QAMRUN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2191

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/586,410 | Applicant(s) CLARK ET AL. | |
| | Examiner Qamrun Nahar | Art Unit 2191 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is in response to the RCE filed on 5/19/05.
2. The objection under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim to claims 2, 12 and 17 is moot in view of applicant's amendment.
3. The rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention to claims 16-18 is withdrawn in view of applicant's amendment.
4. Claims 1, 3, 6, 8, 11, 13 and 16 have been amended.
5. Claims 2, 7, 12 and 17 have been canceled.
6. Claims 1, 3-6, 8-11, 13-16 and 18 are pending.
7. Claims 1, 6, 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583).
8. Claims 3-5, 8-10, 13-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583), and further in view of Applicant Admitted Prior Art (hereinafter AAPA).

Response to Amendment

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 6, 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583).

Per Claim 1 (Amended):

Chang teaches a system (“system” in column 2, lines 46-47 and Fig. 1), comprising: a translator adapted to translate between extended grammar constructs of a machine readable language and basic grammar constructs of said machine readable language (“pre-compiler” in column 2, lines 53-68 to column 3, lines 1-6, pre-compiler is interpreted as a translator; supplemental language is interpreted as extended grammar constructs; and host language is interpreted as basic grammar constructs), wherein a translation comprises reading a source file containing extended grammar constructs, performing a lookup table conversion of said source file of extended grammar constructs into a basic source file containing only basic grammar constructs, said translator configured to implement multiple configurable levels of precompilation (column 3, lines 1-6; column 4, lines 55-68 to column 5, lines 1-21; and see Fig. 2; Multiple configurable levels of precompilation are shown in Figure 2, i.e., “Declaration Mode” is one level, and “SQL Statement” is another level.); and a compiler coupled to receive an output of said translator for compiling code written in said basic grammar constructs, wherein said compiler generates executable code implementing a function of the extended grammar constructs as compiled basic grammar constructs (“The modified source file 22 can then be compiled by a host language compiler 24” in column 3, lines 13-16). Chang does not explicitly teach that the machine readable language being ASN.1. Bapat teaches that the

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machine readable language being ASN.1 (column 3, lines 10-16 and see Fig. 20, item 14 “ASN.1 SOURCE FILES WITH OBJECT CLASS DEFINITIONS”; ASN.1 source files contain ASN.1 grammar constructs, which is compiled into machine readable language).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by Chang to include the machine readable language being ASN.1 using the teaching of Bapat. The modification would be obvious because one of ordinary skill in the art would be motivated to use standardized data structure protocol.

Per Claim 6 (Amended):

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “a first source file” (column 2, lines 59-60), and “a second source file” (column 3, lines 3-6). Thus, accordingly, this claim is also obvious.

Per Claim 11 (Amended):

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Per Claim 16 (Amended):

This is a computer-readable computer program product version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed

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and/or covered in cited areas as set forth above, including “wherein said computer-readable program code is adapted to directly translate said extended grammar constructs into said basic grammar constructs by using one or more lookup tables” (column 3, lines 1-6 and Fig. 1, item 36). Thus, accordingly, this claim is also obvious.

11. Claims 3-5, 8-10, 13-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583), and further in view of Applicant Admitted Prior Art (hereinafter AAPA).

Per Claim 3 (Amended):

The rejection of claim 1 is incorporated, and further, neither Chang nor Bapat explicitly teaches that the basic grammar constructs comprises X.680 grammar constructs. AAPA teaches that the basic grammar constructs comprises X.680 grammar constructs (pg. 1, line 32).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by the combination of Chang and Bapat to include the basic grammar constructs comprising X.680 grammar constructs using the teaching of AAPA. The modification would be obvious because one of ordinary skill in the art would be motivated to use a common basic compiler.

Per Claim 4:

The rejection of claim 3 is incorporated, and further, neither Chang nor Bapat explicitly teaches that the extended grammar constructs comprises at least one of X.681,

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X.682, or X.683 grammar constructs. AAPA teaches that the extended grammar constructs comprises at least one of X.681, X.682, or X.683 grammar constructs (pg. 1, lines 27-31).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by the combination of Chang and Bapat to include the extended grammar constructs comprising at least one of X.681, X.682, or X.683 grammar constructs using the teaching of AAPA. The modification would be obvious because one of ordinary skill in the art would be motivated to develop applications using other grammar constructs.

Per Claim 5:

The rejection of claim 4 is incorporated, and Chang further teaches that the translator comprising one or more lookup tables (column 3, lines 1-6 and Fig. 1, item 36).

Per Claim 8 (Amended):

This is a method version of the claimed system discussed above, claim 4, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Per Claim 9:

This is a method version of the claimed system discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

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Per Claim 10:

This is a method version of the claimed system discussed above, claim 5, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “equivalent constructs” (Chang, column 3, lines 1-6). Thus, accordingly, this claim is also obvious.

Per Claims 13 (Amended) & 14-15:

These are method versions of the claimed system discussed above (claims 3, 4, and 5, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

Per Claim 18:

This is a computer-readable computer program product version of the claimed system discussed above (claims 3 and 4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Response to Arguments

12. Applicant's arguments filed on 5/19/05 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

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a) As discussed in response to previous Official Actions ...

In contrast, as described in the Summary of the Invention, an object of Chang is to provide a translator for computer source code which *simplifies the writing of pre-compilers*. It is a further object of Chang to allow pre-compilers to be written without requiring detailed knowledge of an underlying supplemental system.”

To do so, Chang provides that ...

Chang thus provides for translating language specific program source code ...

The present invention, however, translates extended grammar constructs into basic grammar constructs, “wherein said compiler generates executable code implementing a function of the extended grammar constructs as compiled basic grammar constructs,” i.e., without conversion into a separate language independent format. Furthermore, Chang nowhere provides for “multiple configurable levels of precompilation.”

Bapat is relied on for allegedly teaching ASN.1 as “a machine readable language.” Bapat, however, relates merely to “storing ASN.1 object instances in a relational database language such as SQL.” Col. 1, lines 21-22. Like Chang, Bapat appears to have nothing to do with translating extended grammar constructs into basic grammar constructs, “multiple configurable levels of precompilation,” or “wherein said compiler generates executable code implementing a function of the extended grammar constructs as compiled basic grammar constructs” as generally recited in the claims at issue. As such, the Examiner is respectfully requested to reconsider and withdraw the rejections.

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Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that the combination of Chang and Bapat fails to disclose the claimed limitations recited in claims 1, 6, 11 and 16. The combination of Chang and Bapat clearly shows each and every limitation in claims 1, 6, 11 and 16.

Chang is relied upon for the limitations "said translator configured to implement multiple configurable levels of precompilation" (column 3, lines 1-6; column 4, lines 55-68 to column 5, lines 1-21; and see Fig. 2; Multiple configurable levels of precompilation are shown in Figure 2, i.e., "Declaration Mode" is one level, and "SQL Statement" is another level.); "and a compiler coupled to receive an output of said translator for compiling code written in said basic grammar constructs, wherein said compiler generates executable code implementing a function of the extended grammar constructs as compiled basic grammar constructs" ("The modified source file 22 can then be compiled by a host language compiler 24" in column 3, lines 13-16).

Furthermore, in response to applicant's argument that the present invention translates "without conversion into a separate language independent format", the transitional term "comprising", is inclusive or open-ended and *does not exclude additional*, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003). Therefore, Chang is permitted to have *additional*, unrecited elements or method steps.

In addition, see the rejection above in paragraph 10 for rejection to claims 1, 6, 11 and 16.

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In the remarks, the applicant argues that:

b) Claims 3-5, 8-10, 13-15, and 18 were rejected ... Chang and Bapat have been discussed above. Applicant Admitted Prior Art is indicated to merely specify particular ASN.1 grammar extensions. Because, however, APAA fails to relate in any way to a translator as recited in the claims at issue (indeed, that is a very object of the present invention), its combination with Chang and Bapat likewise fails to teach, suggest or imply the present invention. As such, the Examiner is respectfully requested to reconsider and withdraw the rejections.

Examiner's response:

b) Examiner strongly disagrees with applicant's assertion that the combination of Chang, Bapat and AAPA fails to disclose the claimed limitations recited in claims 3-5, 8-10, 13-15, and 18. The combination of Chang, Bapat and AAPA clearly shows each and every limitation in claims 3-5, 8-10, 13-15, and 18.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, see the rejection above in paragraph 11 for rejection to claims 3-5, 8-10, 13-15, and 18.

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Conclusion

13. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


WEI Y. ZHEN
PRIMARY EXAMINER

QN
August 4, 2005